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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,116	01/24/2005	Philip Head	US21.1268	2126
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EXAMINER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,116

**Applicant(s)**

HEAD ET AL.

**Examiner**

NICOLE COY

**Art Unit**

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 12-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Coenen et al. (USP 6,305,469).

With respect to claim 1, Coenen et al. discloses a method of drilling a borehole from a selected location in an existing wellbore penetrating a subterranean earth formation having at least one hydrocarbon bearing zone wherein the existing wellbore is provided with a casing and a hydrocarbon fluid production conduit (70) is arranged in the existing wellbore in sealing relationship with the wall of the casing, the method comprising: passing a remotely controlled electrically operated drilling device (3) from the surface through the hydrocarbon fluid production conduit to the selected location in the existing wellbore; operating the drilling device such that cutting surfaces on the drilling device drill the borehole from the selected location in the existing wellbore thereby generating drill cuttings wherein during operation of the drilling device (see column 5 lines 18-30), a first stream of produced fluid flows directly to the surface through the hydrocarbon fluid production conduit and a second stream of produced fluid is pumped over the cutting surfaces of the drilling device via a remotely controlled electrically operated downhole pumping means (14) and the drill cuttings are

transported away from the drilling device entrained in the second stream of produced fluid (see column 5 lines 27-55).

With respect to claim 2, Coenen et al. disclose that the existing wellbore has an upper cased section (66) and a lower uncased section (see figure 2).

With respect to claim 3, Coenen et al. disclose that the cutting surfaces (13) of the drilling device are located on a drill bit or mill that is provided at or near the lower end of the drilling device and optionally on a drill bit or mill that is provided at or near the upper end of the drilling device.

With respect to claim 4, Coenen et al. disclose that the drill bit or mill is expandable (via extendable grippers 44) thereby allowing the borehole that is drilled from the selected location to be of a larger diameter than the inner diameter of the production conduit.

With respect to claim 5, Coenen et al. disclose that the drilling device is provided with an electrically operated steering means for the drill bit or mill (see column 4 line 38 to column 5 line 11).

With respect to claim 6, Coenen et al. disclose that the drilling device is provided with an electric motor (9) for actuating a means for driving the drill bit or mill.

With respect to claim 7, Coenen et al. disclose that the drilling device is provided with the electrically operated pumping means (14).

With respect to claim 8, Coenen et al. disclose that the drilling device is provided with an electrically operated traction means (44).

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With respect to claim 9, Coenen et al. disclose that the borehole that is drilled from the selected location is (a) a new section of wellbore (see column 2 lines 31-33); (b) a window in the casing of the existing wellbore or a window in the production conduit and casing of the existing wellbore (see column 2 lines 31-33); (c) a perforation tunnel in the casing and cement of the existing wellbore; or (d) an enlarged borehole through at least a section of the existing wellbore having mineral scale deposited on the wall thereof.

With respect to claim 10, Coenen et al. disclose that the drilling device is suspended from a cable (50) that encases at least one wire and/or segmented conductor for transmitting electricity or electrical signals.

With respect to claim 11, Coenen et al. disclose that the drilling device is suspended from the cable via a releasable connection means (51).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coenen et al. in view of Quigley et al.

With respect to claim 26, Coenen et al. does not disclose the electrical conductor wire embedded in the wall of tubing. Quigley et al. discloses embedding the wire in the

tubing in order to ensure that the bending strains on the wire are minimized. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify Coenen et al. by embedding the electrical conductor in a tubing wall as taught by Quigley et al. in order to ensure that the bending strains on the wire are minimized.

With respect to claim 27, Coenen et al. does not disclose an outer fluid barrier and flexible protective sheath. Quigley teaches a fluid barrier and protective sheath in figure 11 in order to protect the wire and inner tubing. It would have been obvious to modify the embodiments of figure 10 in Quigley with the protective tubing and fluid barrier taught in figure 11 in order to protect the wire and inner tubing.

With respect to claim 28, Coenen et al. in view of Quigley et al. disclose drilling a new wellbore section wherein either (a) the second stream of produced fluid is passed to the drilling device through the annulus formed between the hybrid cable and the wall of the new wellbore section and the entrained cuttings stream is transported away from the drilling device through the inner metal tube of the hybrid cable; or (b) the second stream of produced fluid is passed to the drilling device through the inner metal tube of the hybrid cable and the entrained cuttings stream is transported away from the drilling device through the annulus formed between the hybrid cable and the wall of the new section of wellbore (see column 5 lines 27-55).

With respect to claim 29, Coenen in view of Quigley disclose that sensors (56) are provided along the outside of the hybrid cable for transmitting formation data to the surface via the electrical wire(s) and/or segmented electrical conductor(s).

5. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coenen et al. in view of Bailey (USP 6,454,007).

With respect to claim 30, while Coenen discloses drilling a lateral borehole, Coenen does not disclose a whipstock. Bailey discloses using a whipstock in order to guide a drill to form a lateral borehole. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Coenen et al. by using a whipstock as taught by Bailey in order to guide the drill to form a lateral borehole.

With respect to claim 31, Bailey teaches that the whipstock is passed to the selected location suspended from the first drilling device (see figure 2).

#### ***Allowable Subject Matter***

6. Claims 12-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

7. Applicant's arguments filed 2/25/08 have been fully considered but they are not persuasive. Applicant argues that Coenen et al. does not disclose a second stream of produced fluid. However, Coenen et al. discloses that produced fluid flows via tubing 70 into the wellhead (see column 5 lines 18-30). The fluid that exits the wellbore is considered a first stream. Coenen et al. also discloses that a pump 14 operates to pump production fluid over the drill bit. This fluid which has not exited the wellbore and

is instead used to carry away the drill cuttings is considered a second stream. Thus, Coenen et al. discloses two distinct streams: one that exits the wellbore without going through the pump, and one that is circulated through pump 14 and contains drill cuttings. Applicant also argues that the invention calls for a second parallel stream of fluid. It is noted that "a parallel" stream is not claimed.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE COY whose telephone number is (571)272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William P Neuder/  
Primary Examiner, Art Unit 3672

nac